

In the United States Patent and Trademark Office  
William E. McLaughlin

Application filed Nov. 2, 2001, benefiting from 01/21/99

Preliminary Examination for allocating subclass  
Southampton, PA 18966-4545  
November 2, 2001

**Preliminary Amendment substituting pending claims for original claims**

Please cancel what were original claims 3,4, and 5 [identified as 1-3] and substitute the apparatus claims as sought in the CPA application, being now numbered 4-6 instead of the numbers 21-23 in the CPA application.

4. A monitoring device useful in seeking to retrieve a lost item, said lost item having surface components selectively responsive to a laser beam having an explicit wave length selected from the atmospheric penetrating group consisting of 880 nm., 1310 nm., and 1550 nm., said monitoring device comprising

a source of electric power;

means actuated by said electrical power for generating a laser beam having a wavelength corresponding to said components selectively responsive to such laser beam; receptor cells responsive to the feedback light from said laser beam; amplifier means amplifying the electrical signal generated by said feedback; and

indicating means alerting a searcher to the varying intensity of such feedback when the laser beam scans a search zone possibly containing such temporarily lost item.

5. The monitoring means of claim 4 in which the indicating means features an audio signal.

6. The monitoring means of claim 4 in which the laser beam has a wavelength of 1310 nm.

*John R. Embark Jr. (4853)*

Art Unit: 3729

**Reason For allowance**

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with

John Euwbank on 7/30/01.

The application has been amended as follows:

Cancel claims 17-20

3. The following is an examiner's statement of reasons for allowance: The prior art of record does not render the claims obvious for a method of retrieving a lost item, said lost item having a hologram selectively responsive to a laser beam having a fog-penetrating wave length selected from the group consisting of 880nm, 1310nm and 1550nm, directing from a monitoring device controlled by the searcher and initially remote from said lost item a laser beam having the explicit wavelength corresponding to said hologram said laser beam being directed into a search zone in which the temporally lost item is believed to be; amplifying the signal indicative of the intensity of the feedback light from such zone; using the amplified signal from such monitoring device for evaluating the whereabouts of the temporally lost item while approaching the targeted

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zone of the hologramized item, whereby the temporally lost item becomes visible to the searcher.:.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Smith whose telephone number is (703) 305-0831.

*Lee Young*  
8/14/01  
LEE YOUNG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

SS

August 27, 2001

In the United States Patent and Trademark Office

Southampton, PA 18966-4545

November 2, 2001 [note that filing was attempted on August 9, 2001 by FAXing to 703-746-4256]

**McLAUGHLIN APPLICATION FOR APPARATUS CLAIMS**

Assistant Commissioner of Patents,

Box Patent Applications-

Washington, DC 20231

Sir:

**WHY THIS APPLICATION MERITS EXPEDITED PROSECUTION AS IF IT WERE  
UNAMBIGUOUSLY ENTITLED FROM THE FIRST TO BE CALLED A  
DIVISIONAL APPLICATION**

This application has a specification identical to that of a pending application now in the Publications group because of a Notice of Allowability issued September 7, 2001. Such allowed pending application has method claims and is a CPA application filed July 6, 2001 derived from parent application 09/235,6198, filed 01/21/99. Dr. Sean Smith was the Examiner throughout the prosecution. He is in Group 3729, headed by Lee Young. The applicant and inventorship herein are identical to such parent and CPA cases. The claims which are effectively sought herein are identical to the apparatus claims which previously were sought in the CPA application. When the parent case was filed, it included both method claims and apparatus claims. Such original apparatus claims are resubmitted [to maximize similarity to parent case as filed] but are cancelled by a Preliminary Amendment substituting the apparatus claims that were in the CPA case when capitulating to the Examiner's erroneous requirement for cancellation of the apparatus claims.

Counsel cannot quote a class and subclass for the presently sought claims because Examiner Smith never make a conventional restriction requirement.

When the case was filed on Jan. 21, 1999, there were both method and apparatus claims. In each of four amendments, applicant argued for the allowability of both method and apparatus claims, never making any election between them. The Examiner did not then raise any issue about restriction. Then in the Final Rejection, Examiner Smith quite erroneously asserted that method claims had

McLAUGHLiN Divisional Apparatus Application of 11/02/01 benefiting from 01/21/99

been elected, and required the cancellation of the apparatus claims in order to expedite a Notice of Allowability of the method claims. The restriction requirement was a baffling surprise feature in a Final Rejection. Legal authorities were cited in attacking the restriction requirement, but Examiner Smith repeated it in the response to the After Final amendment. It seemed wiser strategy to pay an extra filing and issue fee than to use appellate procedures involving delays, lawyer's time, etc. to try to overcome the hurdles arising from this baffling surprise. The client desired early issuance of a patent.

Because the present application benefits from the 01/21/99 filing date, it is tentatively designated as a **CONTINUATION APPLICATION, even though it will probably be treated essentially as a DIVISIONAL APPLICATION after the issuance of the filing receipt with its class-sub-class Group designations. This case should be processed with great speed.**

The documents for the application containing the apparatus claims were predominantly prepared in response to a telephone conversation with Examiner Sean Smith on Wednesday Aug. 9, 2001. The Examiner seemed adamant that if both method and apparatus claims were desired, it would be necessary to file a separate case for the apparatus claims, which he indicated could be done following the CPA procedure of FAXing the application to his new private FAS number 703-746-4256. Accordingly, Counsel filed what was intended to be this application by FAX on Aug. 9, 2001. Counsel did not send a form requesting a FAX reply because of Counsel's unawareness of the availability of the FAX-reply form. It was subsequent to Aug. 9, while browsing through the availability of Forms on line that Counsel discovered that there is a reply form for COA applications filed by FAX. Counsel is 85 years old, and has had as many as 9 patent applications pending, but is quasi-retired, and accordingly relies more upon guidance from the Examiner than some patent attorneys having a more active prosecution practice

Counsel did phone Examiner Smith a few days after the FAXing and had oral confirmation that the FAX had been received and that the case was on file. Said FAX transmittal included the documents for paying the fee from the Deposit Account. When the filing fee was not routinely deducted from the Deposit Account, Counsel made a series of Status Inquiries, including leaving messages on the VoiceMail of Examiner Smith several times, inquiries at the Initial Examination

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section, and the like, every few weeks. Counsel's persistent inquiries to the Patent Office brought on Thursday, September 25 the surprising news that currently the Patent Office does not accept the filing of a Divisional Application by FAX. Such surprising news prompted counsel to communicate with the office of his Arlington, VA associate, Eric Scherlin. A week later, on Thursday, November 1, said office phoned to explain that efforts to obtain access to the CPA of 09/235,618 had been unsuccessful, so that the apparatus application could not easily contain documentary evidence concerning the filing by FAX on Aug. 9, 2001. Preparations for filing this application started immediately, but could not be completed until Friday, November 2, 2001.

Although the two patents will expire simultaneously under the 20 year term statute, counsel tried valiantly to seek simultaneous issue of the two patents. Prior to the 20 year term statutes, many courts were quite confused about "double patenting" as clarified in Stringham's book on Double Patenting. From 1937 onward, counsel particularly stressed the books about patent law by Stringham. However, today Stringham is almost unknown to many patent professionals. Stringham had respect for many court decisions concerning some aspects of intellectual property law, but contempt for the amazing confusion about double-patenting. Some of those asinine decisions have never been explicitly overruled. Some of the double patenting decisions contain language connoting that the Patent Office cannot be accused of error and that only counsel for applicant can be blamed if any mistakes were made. The Stringham book on double patenting encouraged efforts to seek both simultaneous expiration and simultaneous issue to avoid raising double patenting issues. Modern decisions probably acknowledge that mere simultaneous expiration avoids all double patenting problems. The prosecution record establishes the intent to avoid any double patenting problem, including the effectiveness of counsel's commitment to perennial common ownership of the differently numbered patents. The record also clarifies that counsel became a part-owner of such patent property during the prosecution, and is a shareholder in the common assignee, a corporation having essentially no assets except such patent property.

Substantially all patentability issues have been decided because the method claims, throughout the prosecution, had apparatus limitations, and the apparatus claims feature method limitations. Now that Examiner Smith has made it necessary to deal with two patent applications

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instead of one, there is hope that the Patent Office can make an adequate search for the apparatus claims, but also recognize why there appears to be an appropriate basis for a First Action Notice of Allowability for the apparatus claims. The Examiner handling this case, after making a supplemental search, can essentially use Dr. Smith's statement as the reason for allowability. Counsel seeks a prompt and favorable action.

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